

REMARKS

1. In response to the Office Action mailed January 15, 2004, Applicant respectfully requests reconsideration. Claims 21-75 were originally presented in the application. Claims 21, 23, 45, 46, 48, 70 and 71 were rejected and claims 22, 24-44, 47, 49-69 and 72-75 were objected to in the outstanding Office Action. By the foregoing Amendments, claims 21, 45 and 70 have been amended. No claims have been added or canceled. Thus, upon entry of this paper, claims 21-75 will remain pending in this application. Of these 55 claims, three claims (claims 21, 45 and 70) are independent. These Amendments are believed not to introduce new matter and their entry is respectfully requested.

*Information Disclosure Statements*

2. The Examiner indicated that the non-patent references cited in an IDS filed with the present application have not been considered. In accordance with MPEP 609,

The examiner will consider information which has been considered by the Office in a parent application when examining (A) a continuation application filed under 37 CFR 1.53(b) or filed under former 37 CFR 1.60, (B) a divisional application filed under 37 CFR 1.53(b) or filed under former 37 CFR 1.60, or (C) a continuation-in-part application filed under 37 CFR 1.53(b). Such information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent.

(See, MPEP 609(I)(A)(2).)

Because this application is a continuation application filed under 37 CFR 1.53(b), and because the unexamined references were of record in parent application No. 09/974,367 (as properly annotated on the FORM PTO-1449 citing such references), Applicant respectfully asserts that the Examiner has impermissibly excluded these references from consideration and that Applicant is not under an obligation to submit the references in another Information Disclosure Statement.

3. As a courtesy, however, Applicant submits with this paper a copy of the unexamined references, and requests that the Examiner's indicate consideration of such references in the next official communication. To facilitate the process, Applicant also includes a copy of the original FORM PTO-1449 for the Examiner to initial and return to the Applicant.

***Art of Record***

4. Applicant acknowledges receipt of form PTO-892 identifying reference(s) made of record by the Examiner.

***Claim Rejections***

5. Claims 21, 23, 45, 46, 48, 70 and 71 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,195,267 to MacDonald, Jr. *et al.* (hereinafter, "MacDonald"). Based on the above Amendments and Following Remarks, Applicant respectfully requests that these rejections be reconsidered and that they be withdrawn.

6. Applicant has amended the independent claims to recite that the claimed thermally-conductive dielectric coating is a solid coating. Support for this amendment can be found at least at pages 11-22 of Applicant's specification in which embodiments of Applicant's thermally conductive dielectric coating are described.

7. In contrast, MacDonald's thermally conductive material 40 is in a permanent liquid state. That is, MacDonald's thermally conductive gel 40 is a viscous, jelly-like fluid that does not cure into a solid material. This enables the gel 40 to be molded inside of a plastic housing 20, and cast to form negative cavities 42 matching the placement of components such as chips 12, 14 on the PCB 10. The housing 20, with an electrically conductive gel 30 and the thermally conductive gel 40, is then applied to PCB 10 to cover chips 12, 14. (*See*, MacDonald, col. 3, ln. 15 - col. 4, ln. 41.)

8. MacDonald neither discloses, teaches nor suggests providing an electrically non-conductive, thermally conductive, contiguous solid layer as recited in Applicant's amended independent claims. In fact, according to MacDonald, such a viscous material provides various advantages such as adhering to the chips 12, 14 without the need to apply a high clamping force, and protecting the chips from shock and vibration. (*See*, MacDonald, col. 2, lns. 64-67; and col. 4, lns. 9-26, 60-67.) If thermally conductive gel 40 were capable of being cured to form a solid, which it is not, gel 40 would be unable to provide such advantages.

9. For at least these reasons, Applicant respectfully asserts that Applicant's invention as recited in Applicant's amended independent claims are patentable over the art of record. The pending dependent claims are patentable for at least the same reasons.

***Conclusion***

10. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael G. Verga', is written over a horizontal line.

Michael G. Verga  
Reg. No. 39,410  
Tel. (703) 563-2005

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